FILE COPY

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

NO. ~~1017~~ 45

ANDERSON'S-BLACK ROCK, INC.,
Petitioner,

v.

PAVEMENT SALVAGE COMPANY, INC.,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

WALTER J. BLENKO, JR.
1020 North American Rockwell Bldg.
Pittsburgh, Pennsylvania 15222
Attorney for Respondent

DON J. SMITH
1020 North American Rockwell Bldg.
Pittsburgh, Pennsylvania 15222
Of Counsel

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SMITH BROS., LAW PRINTERS, 620 SECOND AVENUE, PITTSBURGH, PA. 15219

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—I—

OPINION BELOW

The Opinion of the court of appeals for the fourth circuit, of which review is sought, is now reported at 404 F. 2d 450.

References herein to the Opinion below will be both to the Federal Reporter and to the Appendix to the Petition.

—II—

JURISDICTION

Respondent admits jurisdiction.

— III —

COUNTERSTATEMENT

This is an ordinary action for patent infringement in the interlocutory stage.

The Neville patent in suit is directed to apparatus for placing bituminous paving material of the sort commonly seen on highways, parking lots and the like. While the use of bituminous paving is old, there has been a long-standing and persistent problem in the existence of "cold joints" or planes of weakness between side by side lanes of bituminous material which led to premature disintegration and failure of the paving. Despite continuous efforts to overcome the problem of cold joints, no successful solution was found prior to the patentee's invention (404 F. 2d at 451; Pet. A2-A3).

A judgment holding the patent invalid under 35 U.S.C. §103 for obviousness and lack of a new result, was entered in the United States district court for the southern district of West Virginia. Its opinion (Pet., A15), is not reported.

The court of appeals reviewed the record, which is replete with credible evidence that the claimed combination was not obvious to men of ordinary skill in the art and that it produced an entirely new and beneficial result — the elimination of cold joints. Pursuant to the rule of *Graham v. John Deere Co.* (1966) 383 U.S. 1, 17, the court of appeals gave careful attention to the scope and content of the prior art, and, upon the basis of the facts revealed, found that there is a new combination not obvious to those skilled in the art. By reason of

those facts, the court reversed the judgment of the trial court, and remanded the action for further proceedings upon issues of infringement.

— IV —

PETITIONER'S "QUESTIONS PRESENTED FOR REVIEW" DO NOT FAIRLY ARISE ON THIS RECORD

The questions presented are contrived questions which are not fairly presented by the record or the decision of the court of appeals.

Question 1 (Pet., 2) does not arise. The court of appeals, on reviewing the evidence, held that the elements of the patent in suit, when brought together in combination, do in fact produce a new and useful result not produced by these elements individually. Thus, the decision is in full recognition of and follows the rule of *Lincoln Engineering Co. v. Stewart-Warner Corp.*, (1937) 303 U.S. 545, and *A & P Tea Co. v. Supermarket Corp.*, (1950) 340 U.S. 147. The reversal resulted from a recognition of evidence which had been overlooked by the district court, and follows from the application of settled rules of law to the specific facts of this case.

Question 2 (Pet. 2) does not arise. The decision of the court of appeals is based upon a recognition that the combination claimed in the patent has overcome the cold joint problem (404 F.2d at 450; Pet. A1), that the combination is novel, and that it has obvious utility of practical and economical importance (404 F.2d at 452; Pet. A4). There is, therefore, a valid combination

within the meaning of the patent law and not an "aggregation" as contended for in the Petition.

Question 3 (Pet., 3) likewise does not arise. The primary defense below was that the claimed invention was obvious. The initial incredulity in the art and the later adoption of the invention was relied upon by the court of appeals to show that the invention was not obvious to men skilled in the art (404 F.2d at 453, Pet. A7-A8).

—V—

ARGUMENT

Each of the questions presented is postulated upon assertions of "aggregation" which do not find support within the record. The court of appeals found that there is a new and useful result in the claimed combination and that the claimed combination produces a new result which the constituent parts do not produce separately. The existence of a new result is not denied. On the contrary, Aeroil, which conducted the defense, proclaimed to the world outside of the courtroom that the claimed invention was "revolutionary" "a new development", and a "dramatic breakthrough" (404 F.2d at 454; Pet., A8).

The record and decision below do not present any question of aggregation. What appears is an application of the facts disclosed by the entire record in accordance with applicable rules of law including *Lincoln Engineering v. Stewart-Warner Corp., supra,* 303 U.S. 545, and *A & P Tea Co. v. Supermarket Corp., supra,* 340 U.S. 147.

This Court has uniformly held that it will not grant Certiorari to review fact questions, particularly where, as here, they do not involve principles of public importance as distinguished from the mere interests of the litigants: *Magnum Co. v. Coty,* (1923) 262 U.S. 159, 163; *Layne & Bowler Corporation v. Western Well Works, Inc., et al.* (1923) 261 U.S. 387, 393; *Forsyth v. Hammond,* (1896) 166 U.S. 506, 514.

The Petition should be denied.

Respectfully submitted,

WALTER J. BLENKO, JR.
1020 North American Rockwell Bldg.
Pittsburgh, Pennsylvania 15222
Attorney for Respondent

DON J. SMITH
1020 North American Rockwell Bldg.
Pittsburgh, Pennsylvania 15222
Of Counsel

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